

Translation

PATENT COOPERATION TREATY

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PCT/EP2003/008793



# PCT

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference SM5254-01WO	<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP2003/008793	International filing date (day/month/year) 07 August 2003 (07.08.2003)	Priority date (day/month/year) 31 August 2002 (31.08.2002)
International Patent Classification (IPC) or national classification and IPC A61K 7/021		
Applicant SCHWAN-STABILO COSMETICS GMBH & CO KG		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 6 sheets, including this cover sheet.  
☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of \_\_\_\_\_ sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 31 March 2004 (31.03.2004)	Date of completion of this report 10 November 2004 (10.11.2004)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

# INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP2003/008793

## I. Basis of the report

### 1. With regard to the elements of the international application:\*

- ☒ the international application as originally filed
- ☒ the description:  
 pages \_\_\_\_\_ 1-17 \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☒ the claims:  
 pages \_\_\_\_\_ 1-35 \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, as amended (together with any statement under Article 19  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☐ the drawings:  
 pages \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☐ the sequence listing part of the description:  
 pages \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_

### 2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

### 3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

### 4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/fig \_\_\_\_\_

### 5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).\*\*

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

\*\* Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP 03/08793

**I. Basis of the report**

1. This report has been drawn on the basis of *(Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.)*:

Reference is made to the following documents:

D1: DE 202 13 416 U (SCHWAN-STABILO COSMETICS GMBH & CO)  
30 January 2003 (2003-01-30)

D2: US-A-5 800 818 (LABORATORIES DE BIOLOGIE VEGETALE  
YVES ROCHER) 1 September 1998 (1998-09-01)

D3: PATENT ABSTRACTS OF JAPAN & JP 2000 297013 A (NARIS  
COSMETICS CO LTD) 24 October 2000 (2000-10-24)

D4: WO 02 38109 A (ORION CORPORATION) 16 May 2002 (2002-  
05-16), mentioned in the application

D5: GB-A-1 134 170 (CLEVELAND & COMPANY) 20 November 1968  
(1968-11-20)

D6: US-A-4 871 536 (L'OREAL) 3 October 1989 (1989-10-03)

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

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**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. Statement**

Novelty (N)	Claims		YES
	Claims	1-7, 12-16, 18-19, 21-22	NO
Inventive step (IS)	Claims		YES
	Claims	1-35	NO
Industrial applicability (IA)	Claims	1-35	YES
	Claims		NO

**2. Citations and explanations**

Document D1, which was cited in the search report as a P document, is not considered prior art within the meaning of chapter II of the PCT Proceedings. However, the examination of this document for novelty and inventive step largely depends upon the analysis of the claimed right to priority of the present application and will be carried out only in the regional European procedure.

Novelty (PCT Article 33(2))

Expressions such as "preferably" and "in particular" do not have a limiting effect on the scope of protection of a claim; in other words, the feature appearing after an expression such as this should be considered entirely optional. Furthermore, any preparation containing a solid phase and only one drop of vegetable-based fat or oil should be considered prejudicial to the novelty of claim 1 (e.g. vegetable stock).

Document D2 (see examples 2 and 4) describes cosmetic compositions of vegetable components containing jojoba oil and carnauba wax. This document is prejudicial to the novelty of claims 1-7, 12 and 21.

Document D3 (see abstract) describes a gluten or its components, an oil phase and a lipstick composition containing dyes. The oil phase consists either of liquid paraffin, jojoba oil, castor oil and isopropyl myristates or of dimethylpolysiloxanes, and the dyes consist of titanium dioxide or nylon powder. Document D3 is prejudicial to the novelty of claims 1-3, 6, 12-14, 16, 18, 19 and 21-22.

Document D4 discloses lipstick compositions containing carnauba wax, *Butyrospermum parkii* or candelilla cera (wax) that challenge the novelty of claims 1-3, 5-7, 12 and 21-22 (see examples 3-4).

Document D5 (see examples 1-3 and 13) discloses lipstick compositions containing candelilla wax and pigment that fall within the scope of claims 1-2, 5, 7, 12, 14, 16, 18-19 and 21-22 of the present application.

Document D6 describes cosmetic compositions containing carnauba wax (example 8) and even hydrogenated castor oil (example 9) as well as various pigments and fillers. Document D6 is prejudicial to the novelty of claims 1-2, 4-5, 7, 12-16, 18 and 21-22.

#### Inventive Step (PCT Article 33(3))

The examination of inventive step in the present application must be postponed until the subject matter of the claims is clearly, acceptably and unequivocally novel.

#### Industrial Applicability (PCT Article 33(4))

Industrial applicability is established for the subject matter of claims 1-35.

PCT Article 6

Claims 1 and 2 are not supported by the description as required by PCT Article 6, since the scope of these claims goes beyond the scope justified by the description. The reasons are as follows:

- Claims 1 and 2 are worded such that they can encompass all preparations containing a solid phase (this can be just a single component) and only one drop of vegetable-based fat or oil.

Claim 17 is unclear (PCT Article 6 - Lack of clarity) because the particle sizes are not defined in terms of a specific component.

The sunscreen agent according to claim 18, the nanopigments according to claims 19-20 and the preservative or the fragrances according to claims 23 and 24 are not defined in the preceding claims (PCT Article 6 - Lack of clarity).

Miscellaneous

The Latin designations of the plants mentioned should be printed in italics in the application.

In claim 12, the word "additionally" should be deleted because the solid phase is defined as part of the preparation according to claim 1.

The dependence of claims 6, 7 and 13-16 should be redefined. For example, claim 6 should be dependent upon claim 1, 2 or 3 rather than upon one of the preceding claims.